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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,773	08/06/2003	Sidney L. Bursten	2839-002	1703

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ROBERTS ABOKHAIR & MARDULA  
SUITE 1000  
11800 SUNRISE VALLEY DRIVE  
RESTON, VA 20191

EXAMINER

LAMB, TWYLER MARIE

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/635,773	<b>Applicant(s)</b> BURSTEN, SIDNEY L.	
	<b>Examiner</b> Twyler M. Lamb	<b>Art Unit</b> 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/21/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 9, 16, 23, 30, 35, 37, 39 and 46-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Hara (US 2001/0019422).

With regard to claims 1, 9, 16, 23, 30, 35, 37, 39 and 46-47 Hara discloses a booklet system comprising: a preprinted custom booklet component selected for a targeted recipient and having a content controller identifier; a controller, wherein the content controller is adapted to: use the content control identifier received from the pre-printed custom booklet component to obtain instructions; use the instructions to create a just-printed custom booklet component; and use the instructions to marry the pre-printed custom booklet component and the just -printed custom-booklet component to produce a customized booklet for the targeted recipient (page 4, paragraph 0079 - page 5, paragraph 0084).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-8, 10-15, 17-22, 24-34, 36, 38, 40-45 and 48-56 rejected under 35

U.S.C. 103(a) as being unpatentable over Hara (US 2001/0019422) in view of Grady (US2001/0056463).

5. With regard to claims 2, 10, 17, 24, 40 and 47, Hara does not teach wherein the content control identifier is a machine readable code.

Grady discloses wherein the content control identifier is a machine readable code (page 3, paragraph 0042).

Hara & Grady are combinable because they both print booklets

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Hara to include wherein the content control identifier is a machine readable code as taught by Grady.

The suggestion/motivation for doing so would have been to provide simple code that the user could easily read utilizing a scanner or other similar device as taught by Grady on page 3, paragraph 0042 .

Therefore, it would have been obvious to combine Hara with Grady to obtain the invention as specified in claims 2, 10, 17, 24, 40 and 47.

6. With regard to claims 3, 11, 18, 25 and 48, Hara does not teach wherein the system further comprises a feeder/scanner adapted to receive the pre-printed custom

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booklet component, to read the content control identifier, and to send the content control identifier to the content controller.

Grady discloses wherein the system further comprises a feeder/scanner adapted to receive the pre-printed custom booklet component, to read the content control identifier, and to send the content control identifier to the content controller (page 3, paragraph 0042).

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Hara to include wherein the system further comprises a feeder/scanner adapted to receive the pre-printed custom booklet component, to read the content control identifier, and to send the content control identifier to the content controller as taught by Grady.

The suggestion/motivation for doing so would have been to provide simple code that the user could easily read utilizing a scanner or other similar device as taught by Grady on page 3, paragraph 0042 .

Therefore, it would have been obvious to combine Hara with Grady to obtain the invention as specified in claims 3, 11, 18, 25 and 48.

7. With regard to claims 4, 12, 19, 31 and 41, Hara does not teach wherein the pre-printed custom booklet component comprises one or more signatures printed on a web-fed printer and customized for the targeted recipient and the just-printed custom booklet component comprises a cover printed on a sheet-fed printer.

Grady discloses wherein the pre-printed custom booklet component comprises one or more signatures printed on a web-fed printer and customized for the targeted recipient and the just-printed custom booklet component comprises a cover printed on a sheet-fed printer (pages 9-10, paragraph 0102).

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Hara to include wherein the pre-printed custom booklet component comprises one or more signatures printed on a web-fed printer and customized for the targeted recipient and the just-printed custom booklet component comprises a cover printed on a sheet-fed printer as taught by Grady.

The suggestion/motivation for doing so would have been to provide simple code that the user could easily read utilizing a scanner or other similar device as taught by Grady on page 3, paragraph 0042 .

Therefore, it would have been obvious to combine Hara with Grady to obtain the invention as specified in claims 4, 12, 19, 31 and 41.

With regard to claims 5, 30, 32, 36, 38, 42, 53, and 55, Hara discloses wherein the booklet system further comprises a pre-printed generic booklet component and wherein the content controller is further adapted to use the instructions to marry the preprinted custom booklet component, the just-printed custom booklet component, and the pre-printed generic booklet component to produce a customized booklet directed to the targeted recipient (page 4, paragraph 0079 - page 5, paragraph 0084).

With regard to claims 6, 13, 20, 28, 33, 43, 51, 54 and 56, Hara discloses wherein the content identifier is associated with profile data of targeted recipient and wherein the pre-printed generic booklet component is selected from a set of pre-printed generic booklet components for inclusion in the customized booklet using the profile data (page 4, paragraph 0079 - page 5, paragraph 0084).

8. With regard to claims 7, 14, 21, 26, 27, 29, 44 and 49-50, 52, Hara does not teach wherein the profile data of the targeted recipient is selected from the group consisting of an address, a set of preferences, a set of demographic data, and a set of historical data.

Grady discloses wherein the profile data of the targeted recipient is selected from the group consisting of an address, a set of preferences, a set of demographic data, and a set of historical data (page 4, paragraph 0079 - page 5, paragraph 0084).

Hara & Grady are combinable because they both print booklets

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Hara to include wherein the profile data of the targeted recipient is selected from the group consisting of an address, a set of preferences, a set of demographic data, and a set of historical data as taught by Grady.

The suggestion/motivation for doing so would have been to provide simple code that the user could easily read utilizing a scanner or other similar device as taught by Grady on page 3, paragraph 0042 .

Therefore, it would have been obvious to combine Hara with Grady to obtain the invention as specified in claims 7, 14, 21, 26, 27, 29, 44 and 49-50, 52.

With regard to claims 8, 15, 22, 34, 45 and 57, Hara does not teach wherein the booklet is selected from the group consisting of a book, a catalogue, a program, a service manual, a periodical, a report, a legal agreement, and a training manual.

Grady discloses wherein the booklet is selected from the group consisting of a book, a catalogue, a program, a service manual, a periodical, a report, a legal agreement, and a training manual (page 4, paragraph 0079 - page 5, paragraph 0084).

Hara & Grady are combinable because they both print booklets.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Hara to include wherein the booklet is selected from the group consisting of a book, a catalogue, a program, a service manual, a periodical, a report, a legal agreement, and a training manual as taught by Grady.

The suggestion/motivation for doing so would have been to provide simple code that the user could easily read utilizing a scanner or other similar device as taught by Grady on page 3, paragraph 0042 .

Therefore, it would have been obvious to combine Hara with Grady to obtain the invention as specified in claims 8, 15, 22, 34, 45 and 57.

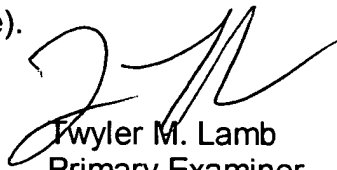
### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-56 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler M. Lamb whose telephone number is 571-272-7406. The examiner can normally be reached on Mon, Tues and Thurs 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Twyler M. Lamb  
Primary Examiner  
Art Unit 2622